



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/573,455	05/26/00	MALLET	J 03804.0114-0

HM22/1002
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EXAMINER
BRUNOVSKIS, P

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/578,453	MALLET ET AL.	
	Examiner	Art Unit	
	Peter Brunovskis	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's cancellation of claims 1-15 and entry of new claims 16-31 in the preliminary amendment, filed 7/18/01 is acknowledged.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 16-21, 25, 26, drawn to a recombinant virus comprising a nucleic acid encoding a mutated form of p53 and its use in method inhibiting toxicity in cultured cells, classified in class 424, subclass 93.2.
- II. Claims 16-20, 25, 26, drawn to a recombinant virus comprising a nucleic acid comprising a p53 binding site and its use in method inhibiting toxicity in cultured cells, classified in class 424, subclass 93.2., classified in class , subclass .
- III. Claims 16-21, 23-26, drawn to a recombinant virus comprising a nucleic acid comprising an antisense RNA which inhibits expression of p53 and its use in method inhibiting toxicity in cultured cells, classified in class 424, subclass 93.2., classified in class , subclass .
- IV. Claims 27-31, drawn to a method for identifying compounds which inhibit p53 activity, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I-III and invention IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the recombinant viruses of inventions I-III can be used in a method of inhibiting toxicity of cultured cells or in a method for identifying compounds that inhibit p53 activity.

Inventions IV and invention I-III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, combination invention IV as claimed does not require the particulars of subcombination inventions I-III since the method of invention IV does not require the recombinant viruses of subcombination inventions I-III (see e.g. cl. 27-28). Further, subcombination inventions I-III have a separate utility for use in a method of inhibiting toxicity of cultured cells.

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper between the methods of I-IV since they constitute patentably distinct inventions comprising different methodologies, different recombinant viruses encoding or comprising different active agents operating by different mechanisms by processes involving different

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technical consideration (e.g. mutant proteins, binding sites, antisense RNAs) or reagents (e.g. glutamate), method steps (e.g. measurement of excitotoxicity), and technical considerations and/or endpoints as a whole requiring separate non-coextensive searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Groups II-IV, and vice versa, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX number is (703) 308-4242 or 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED**, so as to avoid the processing of duplicate papers in the Office.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Brunovskis whose telephone number is (703) 305-2471. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda can be reached at (703) 305-6608.

Any inquiry of a general nature or relating to the status of this application should be directed to the Patent Analyst, Patsy Zimmerman whose telephone number is (703) 308-8338.

Peter Brunovskis, Ph.D.
Patent Examiner
Art Unit 1632


DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800/630